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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/872,640	05/31/2001	Motasim Sirhan	020460000210	1955

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,640

Applicant(s)

SIRHAN ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,12,15-19 and 22-36 is/are pending in the application.
- 4a) Of the above claim(s) 26-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,12,15-19 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This application contains claims 26-36, drawn to an invention nonelected with traverse in Paper Nos. 12 and 18. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The new drawings filed June 21, 2004 have not been entered since they contain new matter. New figures 5D and 5E contain new matter since figure 5D shows the cross-section of catheter body 12 as being elongated in the vertical direction while figure 5E shows the cross-section of catheter body 12 as being elongated in the horizontal direction. The original disclosure is silent as to the direction of the elongation of the cross-section. Therefore each figure contains new matter. Further, the ratio of the height to the width of the cross-sections shown in figures 5D and 5E is not disclosed in the original disclosure.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the oblong and elliptical shapes defined in claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of

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the application. The objection to the drawings will not be held in abeyance.

Claims 1, 3-9, 12, 15-19 and 22-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The embodiment of figures 5A, 5B and 13A, as described in the specification and shown in the drawings, is inoperable. The distal end of inflation tube 26 is shown attached to the back end of inner sleeve 38 in figure 2. Although the inflation tube 26 is slidable within slit 24 since it has a cross-section which is smaller than the cross-section of slit 24, the inner sleeve 38 (which is located relative to the inflation tube 26 as shown in figure 2) will not fit into slit 24. Since the wall of the inner sleeve 38 is located directly in line with the inflation tube 26 as shown in figure 2, the balloon structure 14 is not slidable relative to the catheter body 12 shown in figure 5A, 5B and 13A. If the inner sleeve 38 is located on the outer surface of catheter body 12, it is unclear what tube or other member connects the inflation tube 26 to the balloon. If there is such a tube, it appears

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that it must be smaller in diameter than the width of the narrow portion of slit 24 shown at the outer periphery of catheter body 12 shown in figure 13A (since it must pass radially outward from inflation tube 26 to the balloon through this portion of slit 24). Yet, no tube or its dimensions are disclosed.

Claims 1, 3-9, 12, 15-19 and 22-25 are free of any rejection based upon the prior art of record.

Applicant's arguments filed June 21, 2004 have been fully considered but they are not persuasive. Applicant alleges that the distal end of the inflation tube 26 may extend out of the axial slit 24 so as to attach to the balloon structure 14 and that such a possibility for the connection between inflation tube 26 and balloon 40 would not involve undue experimentation. First of all, no such arrangement is disclosed. Inflation tube 26 is shown in figure 2 as extending linearly from the balloon. Further, it is not clear from the original disclosure that the tube 26 would be sufficiently flexible to make an abrupt bend out of slit 24 and then make another bend to connect to balloon 40. The other possibility of another member or tube connected at the distal end of tube 26 is simply not disclosed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (703)308-2154. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

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mht
9/24/04



MICHAEL THALER
PRIMARY EXAMINER
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